

## REMARKS

Claims 1-11 are pending in the application. Claims 9-11 have been withdrawn. Claims 1-8 have been rejected and are currently under consideration. With this paper, the title, the specification, and claims 2-3, 5, and 7 have been amended.

### Information Disclosure Statement

With respect to the Information Disclosure Statement (IDS) filed on August 27, 2004, the Examiner states:

Further, all the publications cited in the IDS filed on August 30, 2004 have not been considered by the Examiner, because CFR § 1.98 requirement is not met.

Applicants respectfully submit that the IDS filed on August 27, 2004 satisfied all of the requirements of 37 CFR § 1.98, and request that the references listed therein be considered by the Examiner. Pursuant to 37 CFR § 1.98(d):

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

- (1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and
- (2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

As indicated in the IDS, copies of the documents listed on the PTO-1449 were not enclosed with the IDS because all of the documents were previously cited by or submitted to the Patent Office in the prior applications which were relied upon for priority under 37 U.S.C.

§ 120. The prior applications are U.S. Application No. 09/991,411, filed November 16, 2001, U.S. Application No. 09/013,329, filed January 26, 1998, U.S. Application No. 08/824,103, filed March 26, 1997 (now abandoned), and U.S. Application No. 08/818,558, filed March 14, 1997 (now abandoned).

Although the Examiner does not specify which requirement under CFR § 1.98 was not satisfied by the August 27, 2004 IDS, Applicants assume that the Examiner was referring to the fact that copies of the documents listed in the PTO-1449 were not enclosed with the IDS. As indicated above, the IDS fully complied with 37 CFR § 1.98. Accordingly, Applicants respectfully request consideration of all of the documents.

#### Specification

The title of the invention has been amended, thereby making moot the Examiner's objection. The patent applications cited on page 1 of the specification have been updated to indicate the current status.

Applicants respectfully request withdrawal of the Examiner's objections to the specification.

#### Claim Rejections - 35 U.S.C. § 112

Claims 2, 3, 5, and 7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner states, in part:

The antecedent basis for "information in the form of electronic content" (as per claims 2 and 5) and "said leaf" (as per claims 3) has not clearly set forth.

Claims 2 and 5 have been amended to recite "further comprising" in place of "wherein", and claims 3 has been amended to recite "said printed publication" in place of "said leaf".

The Examiner further states, in part:

In addition, the co-relationship and cooperation between the storage media (as per claim 5) and the claimed structure of the remote control (as per claim 4) and the leaf and the printed publication (as per claim 7) are lacking.

Claims 5 and 7 have been amended for clarity making moot the Examiner's rejections under § 112. These non-narrowing amendments are made merely to clarify the subject matter claimed.

Accordingly, Applicants request withdrawal of the Examiner's rejection of claims 2, 3, 5, and 7 under § 112 and allowance therefor.

#### Claim Rejections - 35 U.S.C. § 103

Claim 7 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,327,459. Enclosed is a terminal disclaimer executed on behalf of Smartpaper Networks Corporation, the assignee of the Redford '459 patent and of the present application. Accordingly, the rejection of claim 7 has been overcome.

Claims 1-6 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,327,459, in

view of Redford et. al (U.S. Patent No. 5,597,307). In view of the terminal disclaimer enclosed herewith, the Examiner's rejection of claims 1-6 has been made moot.

Claim 8 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,327,459, in view of Haas et al (U.S. Patent No. 5,954,514). In view of the terminal disclaimer enclosed herewith, the Examiner's rejection of claim 8 has been made moot.

Accordingly, Applicants respectfully request withdrawal of the examiner's rejections of claims 1-8.

CONCLUSION

In light of the foregoing, Applicants respectfully request that the rejections be withdrawn and the claims allowed. Should any other action be contemplated by the Examiner, it is respectfully requested that he contacts the undersigned at (408) 392-9250 to discuss the application.

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Respectfully submitted,



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